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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
TRUONG, THANHNGA B	
ART UNIT	**PAPER NUMBER**
2135	
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10/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No.	Applicant(s)	
	10/808,799	LIPSKY ET AL.	
	Examiner	Art Unit	
	Thanhnga B. Truong	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 August 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the communication filed on August 1, 2007. Claims 1-17 are pending. At this time, claims 1-17 are still rejected.

Response to Arguments

2. Applicant's arguments, filed August 1, 2007, have been fully considered but they are not persuasive.

Applicant argues that:

The combination of the cited references (Ishiguro and Chou) fail to teach or suggest the claimed invention. Specifically, the cited references fail to teach or suggest said database being encrypted using a unique encryption key and the encryption key being derived from a predetermined value that uniquely identifies an authorized location for storing said database

Examiner respectfully disagrees with the Applicant and still maintains that:

Ishiguro teaches the claimed subject matter. In fact, Ishiguro teaches the database being encrypted using a unique encryption key **(column 14, lines 33-55 of Ishiguro).** Although Ishiguro teaches the claimed invention subject matter using encryption key, Ishiguro is silent on the capability of disclosing said encryption key being derived from a predetermined value. On the other hand, Chou teaches this limitation on **column 3, lines 2-13 of Chou, wherein the session key SK is encrypted using a special encryption key EK. The encryption key is derived by the microcontroller 14 from the two unique serial numbers of two hardware tokens belonging to the communicating parties using the secret algorithm implemented in the firmware 15 (emphasis added). The first serial number is the serial number of the sender's hardware token 12 that performs the generation of the EK. The second serial number is accessed from the table inside the non-volatile memory 16 of the hardware token 12 based on the identification number of the communicating party supplied from the computer 14 which, for purposes of illustration, will be assumed to be token 22(j).** Thus, the combination of teaching between Ishiguro and Chou teaches the claimed subject matter. Furthermore, Chou

teaches the second user transmits the encrypted session key together with the identification number of the sending party and the valid second user password through the computer 20 to his hardware token 22. The receiver's hardware token 22 uses the sending party's identification number to **extract the serial number of the first hardware token 12 from the table in its non-volatile memory 16 (emphasis added),** after which the decryption key is derived which is a counterpart for the encryption key EK and is used to decrypt the encrypted session key SK. Based on decryption key DK, the hardware token 22 decrypts the encrypted session key ESK to reveal the session key SK. The decrypted session key SK is transmitted from the recipient hardware 22 token to the computer 20 of the receiving party where it is used to decipher the ciphered message. Only possession of the user's password and a particular token can provide the capability to perform the ciphering of the data to be transmitted at one end of the communication system and to perform the deciphering of the received ciphered data at another end (column 3, lines 36-54 of Chou).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the combination of teaching between Ishiguro and Chou is efficient and proper.

Ishiguro and Chou do not need to disclose anything over and above the invention as claimed in order to render it unpatentable or anticipate. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claimed limitations.

For the above reasons, it is believed that the rejections should be sustained.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishiguro et al (US 7,143,445), and further in view of Chou (US 5,638,444).

a. *Referring to claim 1:*

i. Ishiguro teaches an electronic reference system comprising:

(1) a portable electronic reference device having memory, a keyboard, a display and a processor **(see Figure 3 and more details on column 7, lines 26-65 of Ishiguro)**;

(2) a personal computer having a USB port, a keyboard, a display, memory and a processor **(see Figure 2 and more details on column 6, lines 7-62 of Ishiguro)**;

(3) an electric coupling capable of connecting said device to said personal computer through said USB port such that said memory in said device is accessible to said personal computer **(column 7, lines 32-41 of Ishiguro);**

(4) a reference database capable of being stored in memory; said database being encrypted using a unique encryption key; said encryption key being derived from a predetermined value that uniquely identifies an authorized location for storing said database **(column 14, lines 33-55 of Ishiguro)**; and

(5) wherein said personal computer and said memory of said device are accessed by using authorized software **(column 16, line 64 through column 17, line 10; column 17, lines 26-30 of Ishiguro)**.

ii. Although Ishiguro teaches the claimed invention subject matter using encryption key, Ishiguro is silent on the capability of disclosing said

encryption key being derived from a predetermined value. On the other hand, Chou teaches this limitation on **column 3, lines 2-13 of Chou**.

iii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

(1) have modified the invention of Ishiguro with the teaching of Chou for providing secure and ciphered communications between any type of computer, including laptops and palmtops **(column 1, lines 5-7 of Chou)**.

iv. The ordinary skilled person would have been motivated to:

(1) have modified the invention of Ishiguro with the teaching of Chou to provide a new and improved method and apparatus of providing secure communications between intercoupled computers **(column 1, lines 21-23 of Chou)**.

b. *Referring to claim 2:*

i. The combination of teaching between Ishiguro and Chou teaches an electronic reference system. Chou further teaches:

(1) wherein said predetermined value is a Device Serial Number assigned to said device **(column 3, lines 2-13 of Chou)**.

c. *Referring to claim 3:*

i. The combination of teaching between Ishiguro and Chou teaches an electronic reference system. Chou further teaches:

(1) wherein said predetermined value is a Device Serial Number assigned to said personal computer **(column 3, lines 2-13 of Chou)**.

d. *Referring to claim 4:*

i. The combination of teaching between Ishiguro and Chou teaches an electronic reference system. Chou further teaches:

(1) wherein said predetermined value is a file system serial number assigned to said memory on said device **(column 3, lines 2-13 of Chou)**.

e. *Referring to claim 5:*

i. The combination of teaching between Ishiguro and Chou teaches an electronic reference system. Ishiguro and Chou further teaches:

(1) wherein said predetermined value is a file system serial number assigned to said memory on said device when said database is the first database stored on said memory **(column 14, lines 33-55 of Ishiguro)**; and wherein is a Device Serial Number assigned to said device for any database stored on said memory subsequent to said first database **(column 3, lines 2-13 of Chou)**.

5. Claims 6-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishiguro et al (US 7,143,445), in view of Chou (US 5,638,444), and further in view of Joyce et al (US 6,934,533 B2).

a. *Referring to claim 6:*

i. The combination of teaching between Ishiguro and Chou teaches an electronic reference system, and Ishiguro further teaches:

(1) wherein said authorized software will derive an encryption voucher from the Device Serial Number assigned to the device on which the database is stored in memory and decrypt said database only if said encryption key matches said encryption voucher **(column 2, lines 21-27 of Ishiguro)**.

ii. Although the combination of teaching between Ishiguro and Chou teaches an electronic reference system, however they are silent on the capability of deriving encryption voucher from the Device Serial Number. On the other hand, Joyce teaches this limitation on **column 3, line 45 through column 4, line 11 of Joyce**.

iii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

(1) have modified the combination of teaching between Ishiguro and Chou with the teaching of Joyce for providing secure and ciphered communications between any type of computer, including laptops and palmtops **(column 1, lines 5-7 of Chou)**.

iv. The ordinary skilled person would have been motivated to:

(1) have modified the combination of teaching between Ishiguro and Chou with the teaching of Joyce to provide a new and improved method

and apparatus of providing secure communications between intercoupled computers **(column 1, lines 21-23 of Chou)**.

b. *Referring to claims 7-9:*

i. These claims have limitations that is similar to those of claim 6, thus they are rejected with the same rationale applied against claim 6 above.

c. *Referring to claim 10:*

i. The combination of teaching between Ishiguro, Chou, and Joyce teaches a method for securing digital rights of a database capable of being stored in memory on a portable reference device; said device having a processor, a display and a keyboard, wherein said device is capable of being connected to a PC such that said PC can access said memory in said device, the method comprising the steps of:

(1) encrypting said database with a unique encryption key **(column 14, lines 33-55 of Ishiguro)**;

(2) said unique encryption key being derived from a file system serial number of an authorized location when said database is the first database stored on said memory; said unique encryption key being derived from a Device Serial Number of said authorized location when said database is not the first database stored on said memory **(column 3, lines 2-13 of Chou)**;

(3) storing said database in memory **(column 14, lines 33-55 of Ishiguro)**;

(4) storing said unique encryption key in a header on said memory associated with said database **(column 14, lines 33-55 of Ishiguro)**;

(5) accessing said database by an authorized software program **(column 16, line 64 through column 17, line 10; column 17, lines 26-30 of Ishiguro)**;

(6) reading said header associated with said database to determine the encryption key **(column 14, lines 34-55 of Ishiguro)**;

(7) calculating an encryption voucher **(column 3, line 45 through column 4, line 11 of Joyce)**;

(8) said encryption voucher being derived from a file system serial number of the memory of the location on which the database is stored when said database is the first database and said encryption voucher being derived from a Device Serial Number of the location when said database is not the first database stored on said memory **(column 14, lines 33-55 of Ishiguro), (column 3, lines 2-13 of Chou) and (column 3, line 45 through column 4, line 11 of Joyce)**;

(9) decrypting said database only if said encryption voucher matches said encryption key **(column 11, lines 1-5; column 15, lines 28-37 of Ishiguro).**

ii. Although Ishiguro teaches the claimed invention subject matter using encryption key, Ishiguro is silent on the capability of disclosing said encryption key being derived from a predetermined value. On the other hand, Chou teaches this limitation on **column 3, lines 2-13 of Chou**.

iii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

(1) have modified the invention of Ishiguro with the teaching of Chou for providing secure and ciphered communications between any type of computer, including laptops and palmtops **(column 1, lines 5-7 of Chou)**.

iv. The ordinary skilled person would have been motivated to:

(1) have modified the invention of Ishiguro with the teaching of Chou to provide a new and improved method and apparatus of providing secure communications between intercoupled computers **(column 1, lines 21-23 of Chou)**.

v. Although the combination of teaching between Ishiguro and Chou teaches an electronic reference system, however they are silent on the capability of deriving encryption voucher from the Device Serial Number. On the other hand, Joyce teaches this limitation on **column 3, line 45 through column 4, line 11 of Joyce**.

d. *Referring to claim 11:*

i. The combination of teaching between Ishiguro, Chou, and Joyce teaches a method for securing digital rights of a database capable of being stored in memory on a portable reference device; said device having a processor, a display and a keyboard, wherein said device is capable of being connected to a PC such that said PC can access said memory in said device, and Ishiguro further teaches:

(1) wherein said PC is connected to said device via a USB port **(see Figure 2 and more details on column 6, lines 7-62 of Ishiguro)**.

e. *Referring to claim 12:*

i. The combination of teaching between Ishiguro, Chou, and Joyce teaches a method for securing digital rights of a database capable of being stored in memory on a portable reference device; said device having a processor, a display and a keyboard, wherein said device is capable of being connected to a PC such that said PC can access said memory in said device, and Chou further teaches:

(1) wherein said encryption key is derived by using a mangling algorithm **(column 3, lines 3-13 of Chou)**.

f. *Referring to claim 13:*

i. The combination of teaching between Ishiguro, Chou, and Joyce teaches a method for securing digital rights of a database capable of being stored in memory on a portable reference device; said device having a processor, a display and a keyboard, wherein said device is capable of being connected to a PC such that said PC can access said memory in said device, and Ishiguro further teaches:

(1) wherein said authorized software program that is accessing said database is installed on the PC **(column 16, line 64 through column 17, line 10; column 17, lines 26-30 of Ishiguro)**.

g. *Referring to claims 14-17:*

i. These claims have limitations that is similar to those of claims 10 and 2, thus they are rejected with the same rationale applied against claims 10 and 2 above.

Conclusion

6. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanhnga (Tanya) Truong whose telephone number is 571-272-3858.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached at 571-272-3859. The fax and phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

Thanhnga B. Truong
Primary Examiner AU2135

TBT
October 22, 2007